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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,851	11/04/2003	Hideo Yamagata	017446-0337	5782
22428 7590 03/17/2008 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007				
EXAMINER				
BARQADLE, YASIN M				
ART UNIT		PAPER NUMBER		
2153				
MAIL DATE		DELIVERY MODE		
03/17/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/699,851

Applicant(s)

YAMAGATA, HIDEO

Examiner

YASIN M. BARQADLE

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Response to Amendment

Applicant's arguments filed on December 04, 2007 have been considered and are not deemed persuasive.

- Claims 1-14 are presented for examination.

Response to Arguments

The Applicant argues "There is no teaching or indication that the data center of FUJII contains any type of "instruction mail creating means" that creates, as backup instruction mail, electronic mail that is sent to the portable terminal. The only indication of messages being sent from the data center of FUJII to the portable terminal is in response to the terminal's desire to obtain the phone directory that had been backed up in the data center. (Abstract). In this situation, there is still no teaching or indication in FUJII of backup instruction mail that is created in the data center." (Page 7, fourth paragraph to page 8, first paragraph).

The Examiner respectfully disagrees. FUJII teaches " METHOD AND SYSTEM FOR BACKING UP DATA ON PHONE DIRECTORY INFORMATION IN PORTABLE TELEPHONE SET" see the Title of the invention. FUJII further teaches 5. "In order to fetch the phone directory to the

terminal 1 from the personal computer 5 again, the phone directory (CSV format) mounted in an electronic mail is transmitted to the mail address of the terminal 1 to retain it in the center 3 and it is fetched from the terminal 1 to update data with in the terminal 1" (abstract lines 9-14). Therefore, FUJII teaches sending a message to the address of the cell phone (portable terminal) and fetching (backup data) from terminal 1 (the cell phone). Sending message to terminal 1 mail address and fetching data implies mail instruction creating means as claimed.

Applicant argues "Pollack fails to make up for the deficiencies of FUJII as noted.... These emails are sent from the mobile device, such as a wireless palm device, to a server that then executes the command. ... This is the same approach utilized by FUJII, in that the mobile device sends instruction mail to the server..." (Page 8, paragraph 2).

Examiner respectfully disagrees. Pollack teaches mobile device receiving email message created by another terminal contrary to Applicant's assertion. For example, paragraph 0073-0075 recite "Consider that Joe@aol.com sent his resume as an attachment to jbpollack@palm.thinmail.net. A wireless palm device would receive an email message with the following content.

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To: jbpollack@palm.net From: joe@aol.com Subject: I wanna Job"

This clearly shows the palm device receiving an email message created and transmitted from the email server of the joe@aol.com.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,3,5,7, 9-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over FUJII Nobuyuki (Japanese publication number 2001177624, hereinafter "FUJII") in view of Pollack US Publication Number (20020019851).

As per claims 1,5, and 9-11, FUJII teaches a backup system which backs up memory information in a cell phone (terminal 1, fig. 1) to a terminal by transmitting/receiving electronic mail (see data center 3 and compute 5 of fig. 1 and abstract)), wherein said terminal comprises instruction mail creating means for

creating, as backup instruction mail, electronic mail having information for instructing to perform backup stored in an email portions (mail directory is transmitted for backup via email see abstract), and backup means for analyzing the email portion of the received electronic mail, and when detecting that the mail is backup response mail from said cell phone, decoding a text of the received backup response mail and backing up the text, and said cell phone comprises response mail creating means for analyzing the email portion of the received electronic mail, creating, as backup response mail, electronic mail having a text in which the memory information in said cell phone is coded and written, when detecting that the mail is backup instruction mail from said terminal, and transmitting the mail to said terminal (FUJII shows the invention of creating, converting phone directory and transmitting for a backup via email and fetching the backed up directory and updating (restoring) in the cell phone (terminal 1) (abstract and fig. 1)).

Although FUJII shows substantial features of the claimed invention including backup operation being performed via email message, however FUJII does not explicitly show backup instructions stored in the header portion of the email.

Nonetheless, storing instructions in the header portion of an email message is well known in the art and would have been an obvious modification of the system disclosed by FUJII to include instructions in the header portion, as evidenced by Pollack USPN. (20020019851).

In analogous art, Pollack whose invention is about a "system for management and manipulation stored of stored files... a user identification system which extracts information from the electronic mail item including the from address, destination address, the subject, the reply-to, and the body of the electronic mail item, to enable verification of the sender as a known user of the system, and/or a command parser which recognizes and assembles a command out of the information extracted from the electronic mail.", disclose an email header encoded with command instructions "IG. 5 also shows that email 14 can contain command specification 6 with arbitrary parameters ... The command specification 6 encoded as the destination address 26 of email 14 at the domain address of the system. A fax command requires a phone number locating the desired output fax machine, which in this case is represented in the subject line 27 of email 14. Alternatives, such as encoding the phone number and the command into a single address, such as 8005551212@thinfox.com 28 can be used, as well as placing the

command in the body or other headers of the email." (§ 0042).
(See also §0043 and commands in the header information of figures 5 and 6). Giving the teaching of Pollack, a person of ordinary skill in the art would have readily recognized the advantage of modifying FUJII by employing the system of Pollack in order to execute the command instruction in the header portion to perform actions desired by a remote user or device. One ordinary skill in the art at the time of the invention would do so to allow a user to quickly and easily manage files on a network storage system from any device (§ 007 § 0012).

As per claims 3 and 7 and 13, FUJII in view of Pollack teach the invention wherein the header portion of the backup instruction mail contains authentication information for a terminal-side user which is personal identification information obtained as a result of computing specific header information according to a predetermined algorithm, and said cell phone performs personal identification for the user from specific header information and a computation result based on the predetermined algorithm when receiving backup instruction mail (Pollack shows mechanism of the user identification that can be derived from the "from" address of the email as well as other information carried (encrypted string which must be decoded) in

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the header or body of the message ¶ 0010-0012; ¶ 0038 and ¶ 0066-0067).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over FUJII Nobuyuki (Japanese publication number 2001177624, hereinafter "FUJII") and Pollack et al US Patent Number (20020019851), hereinafter "Pollack" in view of what is well known in the art of backup and restore operations.

As per claim 4, FUJII in view of Pollack teach the wherein said terminal includes a backup (instruction), and said instruction mail creating means automatically creates backup instruction mail in accordance with said backup (instruction) and transmits the mail to said cell phone. However, FUJII in view of Pollack do not show a backup schedule table. Backup systems to have back schedule table is well known in the art at the time of the invention was made. One ordinary skill in the art at the time of the invention would have a backup schedule timetable for the advantage of backing up updated files since the last backup. This enables to have a less information to restore since the most recent backup data.

Claims 2,6,8,12 and 14 are rejected under 35 U.S.C. 103(a) as

being unpatentable over FUJII Nobuyuki (Japanese publication number 2001177624, hereinafter "FUJII") and Pollack et al US Patent Number (20020019851), hereinafter "Pollack" in view of what is well known in the art of message (event) notification.

As per claim 2,6,8,12 and 14, although FUJII and Pollack show substantial features of the claimed invention as explained above, they do not explicitly show notifying a notification destination associated with an owner of a corresponding cell phone of information associated with backup processing upon completion of backup.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by FUJII and Pollack. A person of ordinary skill in the art at the time of the invention would have readily recognized the desirability and the advantage of modifying FUJII and Pollack to transmit a notification means for notifying a notification destination associated with an owner of a corresponding cell phone of information associated with a backup processing upon completion of backup/restore information. One ordinary skill in the art at the time of the invention would do so in order to notify the owner of backed up data the successful completion of backup or restore operation and that no data has been lost.

Conclusion

ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

The prior made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Barqadle whose telephone number is 571-272-3947. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The fax phone numbers for the organization where this application or proceeding is assigned are

703-872-9306 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR system. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Y. M. B./

Examiner, Art Unit 2153

/Glenton Burgess/

Supervisory Patent Examiner, Art Unit 2153